

REMARKS

Applicants thank the Examiner for the courtesy of a telephonic interview on June 9, 2005. During the Interview, the rejection of the claims and the cited references were discussed. No final agreement was reached.

The Claims

The claims, as currently pending, are directed to curable resin compositions, coating comprising such resin compositions, enzyme stripper compositions for the resin compositions of the invention, and methods for making the curable resin compositions of the invention.

As recited in claim 1, the curable resin compositions include an oligomer having one enzyme degradable segment selected from the group consisting of polycaprolactone, polyhydroxy butrate valerate (PHVB), polylactic acid, and copolymers and blends thereof. Claims 2-26, directed to curable resin compositions, directly or indirectly depend from claim 1 and therefore incorporate all the limitations thereof.

Claim 27 is directed to a coating comprising the curable composition of claim 1, and therefore includes the limitations of claim 1.

Claims 28-31 are directed to stripper compositions for the curable resins of the invention.

Claims 32-40 are directed to methods for making curable resin compositions including an oligomer having one enzyme degradable segment selected from the group consisting of polycaprolactone, polyhydroxy butrate valerate (PHVB), polylactic acid, and copolymers and blends thereof.

The Office Action

In the Office Action, claims 1-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,977,269 to Kovar *et al.* (the '269 patent), U.S. Patent No. 6,150,429 to Kovar *et al.* (the '429 patent), or U.S. Patent No. 6,300,457 to Rubin *et al.* (the '457 patent). The Examiner has taken the position that the disclosures of these patents include polyester oligomers, and, while conceding that the cited references "[do] not disclose in the

working examples specific polyesters,” the Examiner further states that “a polymer chemist of ordinary skill in the art would be motivated to modify [the cited patents] by using polyesters.”

The Examiner then states that “[s]uch modification would have been obvious because one would have a reasonable expectation of success that polyesters as taught by [the cited references] would be similarly useful and applicable to specific polyesters of the present invention.”

Applicants cannot agree with the above statements.

As noted above, the pending claims are directed to curable resin compositions including an oligomer having one enzyme degradable segment selected from the group consisting of polycaprolactone, polyhydroxy butrate valerate (PHVB), polylactic acid, and copolymers and blends thereof, and to coatings including such compositions, strippers for the coatings, and methods for making the compositions. While the cited references disclose resin compositions which include, *inter alia*, certain polyesters and certain vinyl dioxolane monomers, the references do not disclose compositions or coatings containing an enzyme-degradable segment of polycaprolactone, polyhydroxy butrate valerate (PHVB), polylactic acid, and copolymers and blends thereof, nor methods of making the same. The cited references simply are *silent* concerning compositions which include the specific claimed compositions, coatings, and methods.

The Examiner appears to take the position that the disclosure, in the cited references, of compositions containing polyesters, is sufficient to render obvious *any* composition containing *any* polyesters. This is not the correct analysis, and Applicants respectfully contend that a *prima facie* case of obviousness cannot be made.

First, as the Examiner has recognized, the MPEP provides that, to establish a *prima facie* case of obviousness, “the prior art reference, or references when combined, must teach or suggest all the claim limitations.” Here, the Examiner has not provided any citation that teaches or suggests compositions containing an enzyme-degradable segment of polycaprolactone, polyhydroxy butrate valerate (PHVB), polylactic acid, and copolymers and blends thereof, nor methods of making the same. As noted above, there is no teaching or suggestion of these specific compositions in any of the cited references (whether taken alone or in combination).

Second, Applicants cannot agree that one of ordinary skill in the art would be motivated to modify the teachings of the cited references to so as to arrive at the claimed invention. The

Examiner has not shown that one of ordinary skill in the art would be motivated to modify the reference teachings to obtain an enzyme-degradable composition, about which the cited references are again silent.

Third, Applicants contend that the skilled artisan would not have had a reasonable expectation that modification of the compositions taught in the cited references would result in an enzyme degradable polymer, as provided by the pending claims. Applicants contend that the general teaching of the cited references cannot provide a reasonable expectation that the specific enzyme degradable compositions of the present claims could be made successfully.

For at least the above reasons, Applicants submit that the Examiner has not established a *prima facie* case of obviousness.

Applicants further submit that, even if the Examiner had established a *prima facie* case of obviousness, the claimed invention is nevertheless not obvious in view of the cited references. As noted throughout the foregoing discussion, the cited references do not teach or suggest that a resin composition can contain an enzyme-degradable segment and thereby provide an enzyme-degradable polymer. Such polymers clearly have advantages not taught or suggested by the cited references. Applicants urge that these unexpected advantages provide an additional basis for distinction over the cited references.

Moreover, the cited references are silent as to the use of enzyme-containing stripper compositions, and therefore cannot anticipate or render obvious the stripper compositions of claims 28-31. Indeed, as the cited references do not teach or suggest that any of the compositions therein disclosed are enzyme-degradable, and in fact do not mention enzymes at all, the cited references cannot provide any teaching or suggestion of enzyme-containing strippers for degrading such degradable compositions.

Reconsideration and withdrawal of the rejections is proper and such action is requested.

Conclusion

For at least the foregoing reasons, it is believed that Claims 1-40 are in condition for allowance. Favorable reconsideration and allowance of this application, therefore, is respectfully requested in response to this communication.

Pursuant to MPEP 509.03, Applicants contend that small entity status continues to be appropriate for this application. Applicants believe that additional fees are not required in connection with this submission. However, if a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge/credit Deposit Account No. **04-1105**.

Respectfully submitted,

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